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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,574	08/05/2003	Ramin Shiekhattar	WSTR-0014C	1505
7590 Licata & Tyrrell P.C. 66 E. Main Street Marlton, NJ 08053		09/10/2007	EXAMINER HOLLERAN, ANNE L	
			ART UNIT 1643	PAPER NUMBER
			MAIL DATE 09/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/634,574	SHIEKHATTAR, RAMIN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anne L. Holleran	1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The amendment filed 8/8/2007 is acknowledged. Claims 4-6 were canceled. Claim 13, previously indicated as allowable, is pending. However, in view of newly discovered references, the finality of the previous Office action is withdrawn and prosecution on the merits continues.

#### ***Claim Rejections Withdrawn:***

2. The rejection of claims 4-6 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, for new matter, is withdrawn in view of the cancellation of claims 4-6.

3. The rejection of claim 5 under 35 U.S.C. 102(b) as being anticipated by Pradier (Pradier, O., et al, J. Cancer Res. Clin. Oncol. 125: 20-27, 1999) as evidenced by Chen (Chen, J.-J. et al, Cancer Research, suppl., 159: 1752s-1756s, 1999) is withdrawn in view of the cancellation of claim 5.

4. The rejection of claim 6 under 35 U.S.C. 102(b) as being anticipated by Blagosklonny (Blagosklonny, M.V., et al. Cancer Res. 55(20): 4623-4626, 1995) as evidenced by Chen (Chen, J.-J. et al, Cancer Research (suppl., 159: 1752s-1756s, 1999) and also as evidenced by Saramaki (Saramaki, A. et al., Nucleic Acids Research, 34(2): 543-554, 2006) is withdrawn in view of the cancellation of claim 6.

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***New Grounds of Rejection:***

***Claim Objections***

5. Claim 13 is objected to because of the following informalities: the term BRCC36 is misspelled as “RBCC36” in line 5 of claim 13. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 refers to methods for identifying an agent that inhibits the expression of “BRCC36” or “BRE protein”. The specification appears to limit BRCC36 to a protein with the sequence of SEQ ID NO: 10 and to limit BRE to a protein with the sequence SEQ ID NO: 9 (see page 5, lines 20-22). However, Ching (Ching, A.K.K. et al., Biochemical and Biophysical Research Communications, 288: 535-545, 2001) teaches that BRE is a protein of multiple isoforms (see abstract). Furthermore, on page 15 of the specification, BRCC36 is identified as SEQ ID NO: 9, and BRE/BRCC45 as SEQ ID NO: 8. Therefore, it is not clear if the terms in the claims “BRCC36” or “BRE” are narrow in scope, i.e. limited to single species, or if the terms are broader in scope, including isoforms, or homologous proteins from other species.

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*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Chiu (US 2007/0010434 A1; effective filing date of 9/16/2002).

Please note that for claim 13, provisional applications 60/401,433 and 60/449,950 do not disclose a method comprising contacting a cell expressing BRE protein with a test compound. Therefore, the effective filing date for this claim is that of the instant application, 8/05/2003.

Chiu teaches SEQ ID NO: 262 (PRO84699; see page 58, line 4, 1<sup>st</sup> column), and teaches a method of comprising contacting a cell expressing a PRO protein with a test agent that may be an antisense molecule and monitoring the ability of the test agent to alter the expression of a PRO protein (see claims 24 and 25). The following sequence alignment between SEQ ID NO: 9 and SEQ ID NO: 262 of Chiu shows that the PRO84699 is the same as the BRE of the instant claims. Thus, Chiu teaches a method that is the same as that claimed.

RESULT 2  
US-10-528-260B-262  
; Sequence 262, Application US/10528260B  
; Publication No. US20070010434A1  
; GENERAL INFORMATION:  
; APPLICANT: Chiu, Henry  
; APPLICANT: Clark, Hilary  
; APPLICANT: Dennis, Kathryn  
; APPLICANT: Fong, Sherman  
; APPLICANT: Schoenfeld, Jill R.  
; APPLICANT: Wood, William I.

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; APPLICANT: Wu, Thomas D.
; TITLE OF INVENTION: Compositions And Methods For Treating Immune Disorders
; FILE REFERENCE: P1983R1
; CURRENT APPLICATION NUMBER: US/10/528,260B
; CURRENT FILING DATE: 2005-03-16
; PRIOR APPLICATION NUMBER: US 60/411,392
; PRIOR FILING DATE: 2002-09-16
; PRIOR APPLICATION NUMBER: PCT/US03/029097
; PRIOR FILING DATE: 2003-09-15
; NUMBER OF SEQ ID NOS: 506
; SEQ ID NO 262
; LENGTH: 415
; TYPE: PRT
; ORGANISM: Homo sapiens
US-10-528-260B-262
```

```
Query Match          100.0%; Score 2240; DB 5; Length 415;
Best Local Similarity 100.0%; Pred. No. 2.9e-210;
Matches 415; Conservative 0; Mismatches 0; Indels 0; Gaps 0;
```

```
Qy      1 MSPEVALNRISPMLSPFISSVVRNGKVGLDATNCLRITDLKSGCTSLTPGPNCDRFLKHI 60
        |||
Db      1 MSPEVALNRISPMLSPFISSVVRNGKVGLDATNCLRITDLKSGCTSLTPGPNCDRFLKHI 60

Qy     61 PYAGETLKWDIIFNAQYPELPPDFIFGEDAEFLPDPSALQNLASWNPSNPECLLLVVKEL 120
        |||
Db     61 PYAGETLKWDIIFNAQYPELPPDFIFGEDAEFLPDPSALQNLASWNPSNPECLLLVVKEL 120

Qy    121 VQQYHQFQCSRLRESSRLMEFYQTLLEEPQYGENMEIYAGKKNWTGEFSARFLLKLPVD 180
        |||
Db    121 VQQYHQFQCSRLRESSRLMEFYQTLLEEPQYGENMEIYAGKKNWTGEFSARFLLKLPVD 180

Qy    181 FSNIPTYLLKDVNEDPGEDVALLSVSFEDTEATQVYPKLYLSPRIEHALGGSSALHIPAF 240
        |||
Db    181 FSNIPTYLLKDVNEDPGEDVALLSVSFEDTEATQVYPKLYLSPRIEHALGGSSALHIPAF 240

Qy    241 PGGGCLIDYVPQVCHLLTNKVQYVIQGYHKREYIAAFLSHFGTGVVEYDAEGFTKLTLL 300
        |||
Db    241 PGGGCLIDYVPQVCHLLTNKVQYVIQGYHKREYIAAFLSHFGTGVVEYDAEGFTKLTLL 300

Qy    301 LMWKDFCFLVHIDLPLFFPRDQPTLTFQSVYHFTNSGQLYSQAQKNYPYSPRWDGNEMAK 360
        |||
Db    301 LMWKDFCFLVHIDLPLFFPRDQPTLTFQSVYHFTNSGQLYSQAQKNYPYSPRWDGNEMAK 360

Qy    361 RAKGCQGSRDACSPWEQVLAFAVAKTGCKLLQPQRNWPSSRGPPWRASEGERTAQ 415
        |||
Db    361 RAKGCQGSRDACSPWEQVLAFAVAKTGCKLLQPQRNWPSSRGPPWRASEGERTAQ 415
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### Conclusion

No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Holleran, whose telephone number is (571) 272-0833. The examiner can normally be reached on Monday through Friday from 9:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, can be reached on (571) 272-0832. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.


Papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Official Fax number for Group 1600 is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Anne L. Holleran

Patent Examiner

September 5, 2007

  
**ALANA M. HARRIS, PH.D.**  
**PRIMARY EXAMINER**